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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,682	08/29/2003	Robert W. Spurr	78253BRRS	9209

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EXAMINER

FUNK, STEPHEN R

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/651,682

Applicant(s)

SPURR ET AL.

Examiner

Stephen R Funk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

The "Other Art" in the information disclosure statement filed August 29, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The TEMIC art has not been provided in a parent application to this application.

Claims 6 and 13 - 21 are objected to because of the following informalities:

In claim 6 line 3 "would" should be --wound--.

Appropriate correction is required.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stephenson et al. (US 5,455,617) in view of Palmer et al. (US 5,530,702).

Stephenson et al. teach a supply spool (70) having a transponder and memory (60) containing data corresponding to the media. Stephenson et al. also teach that the transponder may communicate with the microprocessor (17) within the printer by radio communication. See column 4 lines 17 - 20, column 5 lines 27 - 36, the paragraph bridging columns 6 and 7, and Figures 7 - 9 of Stephenson et al. Stephenson et al. do not teach a transceiver for transmitting first and sensing second electromagnetic fields or a wire connecting the transceiver to the microprocessor. Palmer et al. disclose the conventionality of a transceiver for transmitting a first

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electromagnetic field at a first frequency and sensing a second electromagnetic field at a second frequency emitted by a transponder. See column 2 lines 49 - 59 of Palmer et al., for example. Note that a connecting wire would be inherent so that the transceiver could forward the data to the microprocessor. It would have been obvious to one of ordinary skill in the art to provide the device of Stephenson et al. with a transceiver in view of Palmer et al. so as to remotely access the data in the transponder. By using electromagnetic radiation neither a physical coupling or direct line-of-sight between the two would be necessary as would with wire and optical communication devices.

Claims 2, 4, 5, and 8 - 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harshbarger et al. (US 5,268,708) in view of Stephenson et al. and Palmer et al.

Harshbarger et al. teach a printer having a carousel (30) having a plurality of supply spools (44) and a device (64 - 68) for positioning a selected one of the spools. Harshbarger et al. do not teach a transponder and transceiver for each of the spools. Stephenson et al. teach providing a spool with a transponder (60) and that the transponder may communicate with a microprocessor (17) by radio communication. Stephenson et al. do not teach a transceiver for transmitting first and sensing second electromagnetic fields or a wire connecting the transceiver to the microprocessor. Palmer et al. disclose the conventionality of a transceiver for transmitting a first electromagnetic field at a first frequency and sensing a second electromagnetic field at a second frequency emitted by the transponder. A connecting wire would be inherent so that the transceiver could forward the data to the microprocessor. It would have been obvious to one of ordinary skill in the art to provide the spools in the printer of Harshbarger et al. with a transponder and transceiver in view of Stephenson et al. and Palmer et al. so as to remotely

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access the data in the transponder on the supply spool. With respect to claim 10 it would have been obvious to one of ordinary skill in the art through routine experimentation to store any relevant characteristic of the donor material, such as thickness, as the data in the transponder. See column 7 lines 26 - 42 of Stephenson et al., for example.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harshbarger et al. in view of Stephenson et al. and Palmer et al. as applied to the claims above, and further in view of Kip et al. (US 5,105,190). Kip et al. teach a similar device including an electrically erasable programmable read only memory (EEPROM). See column 2 lines 52 - 56 of Kip et al., for example. It would have been obvious to one of ordinary skill in the art to provide the printer of Harshbarger et al., as modified by Stephenson et al. and Palmer et al., with an EEPROM in view of Kip et al. so as to reprogram the transponder.

Claims 6 and 13 - 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephenson et al. in view of Palmer et al. and Kip et al. (US 5,105,190).

Stephenson et al. and Palmer et al. have been addressed above. Kip et al. teach a similar device including an electrically erasable programmable read only memory (EEPROM). See column 2 lines 52 - 56 of Kip et al., for example. It would have been obvious to one of ordinary skill in the art to provide the printer of Stephenson et al., as modified by Palmer et al., with an EEPROM in view of Kip et al. so as to reprogram the transponder. With respect to claims 13 - 21 it would have been obvious to one of ordinary skill in the art through routine experimentation to store any relevant characteristic of the donor material as the data in the transponder. See column 7 lines 26 - 42 of Stephenson et al., for example.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and

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useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 7, 11, and 12 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 16 - 18 of prior U.S. Patent No. 6,634,814. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 - 6, 8 - 10, and 13 - 21 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 15 and 19 - 21 of U.S. Patent No. 6,634,814. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims anticipate the pending claims since each and every element is recited in the patented claims. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Claims 7, 11, and 12 would be allowable *if* rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 set forth in this Office action. The prior art of record does not

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teach, or properly render obvious, placing an end cap over the transponder disposed in an end portion of the spool.

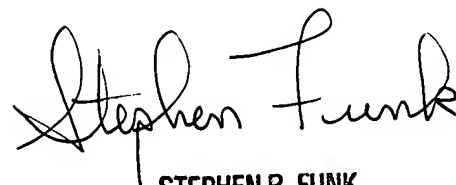
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen R. Funk whose telephone number is (571) 272-2164.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (571) 272-2168.

The fax phone number for ALL official papers is (703) 872-9306. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner at (571) 273-2164.

SRF
August 11, 2004



STEPHEN R. FUNK
PRIMARY EXAMINER